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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,566	08/07/2003	Gerard MacNeil	6337.1041	9853

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EXAMINER

STINSON, FRANKIE L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/635,566

Applicant(s)

MACNEIL ET AL.

Examiner

FRANKIE L. STINSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/7/2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japan'528 (Japan 6-229528) .

Re claim 1 and 8 for example note that Japan'528 discloses an apparatus for scarifying an interior surface of a pipe, comprising: (a) a vehicle (1) moveable along an interior of said pipe; and (b) a fluid nozzle assembly connected to said vehicle, said fluid nozzle assembly having an exchanger coupled to an external source of pressurized fluid, a plurality of branches (see fig. 1) coupled to said exchanger, and a fluid nozzle (14) coupled to a distal end of each of said branches, said branches spaced so that each branch is counterbalanced by one or more other branches of said plurality of branches, said fluid nozzles positioned proximate the interior surface of said pipe, said fluid nozzle assembly being operative to rotate or oscillate and to emit jets of fluid from said fluid nozzles against the interior surface of said sewer pipe and to scarify the interior surface of said pipe as said vehicle moves along the interior of said pipe.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 11, 13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan'528.

Re claims 3, 4 and 11, to have the extendibility provided by replaceable branches or by adding or removing branch section has been deemed to be an obvious matter of design in that it is old and well known to lengthen tubes/conduits in various fashions especially in view of the lengthen and contraction of the branches in Japan'528 (see MPEP 2144.06 SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “ [A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original). This is also applicable to the subject matter of claim 17. Re claim 18, Japan'528 discloses one of the oscillatory manner, a fully rotational manner, and a combination of oscillatory and fully rotational manners.

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6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan'528 in view of either Butterworth (U. S. Pat. No. Re. 19,374) or Harvey (U. S. Pat. No. 5,107,879).

Claims 6 and 7 define over the applied prior art only in the recitation of the counterweight. It should be noted that, like in the instant invention, since the branches are evenly positioned about the exchanger/hub, the system is already provided with counter balance/weight means. Nonetheless, Harvey (as at 52) and Butterworth (see page 3, lines 41-42), disclose the counterbalance means. It therefore would have been obvious to one having ordinary skill in the art to modify the system of Japan'528, to have the branches counterweighted as taught by either Butterworth or Harvey, for the purpose of ensuring proper rotation of the branches as is common in rotating structures.

7. Claims 12, 13, 14, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan'528 in view of Leibner (U. S. Pat. No 3,106,491).

Claims 12, 13, 19 and 20 essentially define over the Japan'528 only in the recitation of the chassis being adjustable. Leibner is cited disclosing the old and well-known concept of providing an adjustable vehicle (see col. 8, lines 3-16). It therefore would have been obvious to one having ordinary skill in the art to modify the system of Japan'528, to be adjustable as taught by Leibner, for the purpose allowing for the system to be used in various size pipes. Re claims 14-16, Japan'528 discloses the power means.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the applied prior art as applied to claim 1 and 8 above, and further in view of Montgomery.

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Claim 16 defines over the applied prior art only in the recitation of the speed selection means. Montgomery discloses the speed being adjusted as claimed (see claim 3). It therefore would have been obvious to one having ordinary skill in the art to modify the device of Japan'528 to include speed adjusting means as taught by Montgomery, for the purpose of ensuring proper speed for sufficient cleaning.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In Boyd et al., Kornhaus, Kirkland, Cerles et al., Pulk, Johnson, Ruholl, Landberger et al., Ericksson, Japan'583, Japan'323, UK'051, note the cleaning means.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANKIE L. STINSON whose telephone number is (571) 272-1308. The examiner can normally be reached on M-F from 5:30 am to 2:00 pm and some Saturdays from approximately 5:30 am to 11:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr, can be reached on (571) 272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fls

  
FRANKIE L. STINSON  
Primary Examiner  
GROUP ART UNIT 1746